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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,061	01/02/2002	Boas Betzler	POU901066US1	9115
46369	7590	02/14/2007	EXAMINER	
HESLIN ROTHENBERG FARLEY & MESITI P.C. 5 COLUMBIA CIRCLE ALBANY, NY 12203			SCUDERI, PHILIP S	
			ART UNIT	PAPER NUMBER
			2153	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/14/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/039,061	BETZLER, BOAS /	
	<b>Examiner</b>	<b>Art Unit</b>	
	Philip S. Scuderi	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 December 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,6,7,10,15-17,20,21,26 and 27 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,6,7,10,15-17,20,21,26 and 27 is/are rejected.
- 7) Claim(s) 1 and 27 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments, pages 12-18 filed 01 December 2006 (hereinafter "Remarks") have been fully considered but they are unpersuasive in their entirety.

1. Applicant argues that Collins (U.S. Pub. No. 2003/0112823) and Vij (U.S. Patent No. 6,452,910) do not teach employing the instant messaging server to establish an instant messaging session between the first wireless device and the at least one other wireless device. Remarks at 14.

The examiner disagrees. As applicant even states "[t]he devices in Collins employ the rendezvous service to provide control information in order to facilitate setting up a direct, peer-to-peer communication between themselves." Id. So, at minimum, the devices employ the rendezvous server to exchange messages which can reasonably be construed as instant messages. Therefore, Collins teaches the limitation in question here.

Furthermore, it is ridiculous to think that the devices never establish a conventional instant messaging session employing the rendezvous service. The mere fact that Collins mentions that the rendezvous service is MSN Messenger implies that the devices never establish a conventional instant messaging session employing the rendezvous service. Collins at [0037]. The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. MPEP § 2112. As practically everyone with any knowledge of the network arts whatsoever knows, establishing a conventional instant messaging session employing the MSN rendezvous service is the most standard use of this service.

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2. Applicant argues that Collins (U.S. Pub. No. 2003/0112823) and Vij (U.S. Patent No. 6,452,910) do not teach use of direct connection wireless technology because use of a firewall allegedly removes the possibility that the devices can be in the same piconet. Remarks at 14-15.

Not only does the examiner disagree, but applicant's own statements completely contradict this argument. Applicant states that “[t]he devices in Collins … facilitate setting up a direct, peer-to-peer communication between themselves.” Remarks at 14 (emphasis added). So, clearly, Collins teaches use of direct connection technology.

Collins further discloses that the devices can be connected to the piconet (the Internet) via “wireless media such as acoustic, RF, infrared, and other wireless media.” Collins at [0035]. So, Collins also teaches use of wireless connection technology.

Therefore, Collins unambiguously teaches use of “direct connection wireless technology” as claimed.

Moreover, applicant's argument fails on its face because the devices are in the same piconet. As the examiner already explained in the last advisory action, the specification states “a piconet is used herein to mean any wireless network with direct peer-to-peer capabilities.” Specification at [0023]. The Internet is indisputably such a network, especially when considering that Collins discloses use of his invention over the Internet. See, e.g., Collins at [0027].

3. Applicant argues that Collins (U.S. Pub. No. 2003/0112823) is directed to processes for enabling communication to be established regardless of communication blockers and that Collins therefore does not describe a piconet with direct connection capabilities. See Remarks at 15.

Again, a piconet is “any wireless network with direct peer-to-peer capabilities.” Specification at [0023]. The Internet is indisputably such a network, especially when considering that Collins discloses use of his invention over the Internet. See, e.g., Collins at [0027]. Applicant states that

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"[t]he devices in Collins ... facilitate setting up a direct, peer-to-peer communication between themselves." Remarks at 14 (emphasis added). So, clearly, Collins teaches use of direct connection technology over the Internet. Because the Internet is a piconet as described by the specification, Collins teaches use of direct connection technology over a piconet.

4. Applicant argues that Collins (U.S. Pub. No. 2003/0112823) does not teach using a list of active wireless devices obtained from the instant messaging server to determine whether the at least one other wireless device in the instant messaging server belongs to the same piconet as the first wireless device. Remarks at 15-16.

Applicant's argument isn't even consistent with the language of the claim. For example, claim 1 recites "employing the list of active wireless devices ... to identify ... whether the at least one other wireless device ... belongs to the same piconet." The mere fact that the network addresses are IP addresses means that any use of the other device's network address identifies that the other device is connected to the Internet (i.e., the piconet). So, Collins teaches the feature as claimed.

5. Applicant argues that Collins (U.S. Pub. No. 2003/0112823) does not teach that the first wireless device transfers the instant messaging session to a peer-to-peer communication model employing direct wireless instant messaging communications across the piconet between the first wireless device and at least one other wireless device.

It is unclear to the examiner what it would even mean to transfer a session to a peer-to-peer communication model. The examiner's best guess is that the limitation means transferring data from the first wireless device using a peer-to-peer communication model." Collins unquestionably teaches the limitation as interpreted. Collins at figure 4b.

***Claim Objections***

Claim 1 is objected to because of the following informalities. The word “firs” in line 21 should presumably be “first.” Appropriate correction is required.

Claim 27 is objected to because of the following informalities. The word “firs” in line 22 should presumably be “first.” Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1, 6, 7, 10, 15-17, 20, 21, 26, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 1 recites the limitation “transferring by the first wireless device the instant messaging session to a peer-to-peer communication model.” It is unclear to the examiner what it would mean to transfer a session to a peer-to-peer communication model. The examiner’s best guess is that the limitation means transferring data from the first wireless device using a peer-to-peer communication model.” The examiner will treat the claim on the merits as best understood.

The other independent claims contain substantially the same limitation and are rejected for the same reasons.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 7, 10, 16, 20, 21, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins (U.S. Pub. No. 2003/0112823) in view of Vij (U.S. Patent No. 6,452,910).**

Regarding claim 1, Collins teaches a method of establishing instant messaging communication between wireless devices, said method comprising:

connecting a first wireless device (100) to an instant messaging server (rendezvous service 400) (figure 4b; paragraph [0037]);

transmitting device address (network address) and access code (login) information of the first wireless device (100) from the first wireless device (100) to the instant messaging server (rendezvous service 400) (paragraph [0036]);

employing the instant messaging server (rendezvous service 400) to establish an instant messaging session between the first wireless device (100) and at least one other wireless device (112) (figure 4b; paragraph [0040]);

subsequent to establishing of the instant messaging session, requesting by the first wireless device (100) a list of active wireless devices from the instant messaging server (rendezvous service 400) in a same piconet (the Internet) as the first wireless device (100) (figure 4b; paragraph [0040]; Device 100 attempts to establish direct connection 410. The rendezvous service must send device 112's address to device 100 to attempt to establish the direct connection.);

transferring from the instant messaging server (rendezvous service 400) to the first wireless device (100) the list of active wireless devices in the same piconet (the Internet) as the first wireless

device (100) (The rendezvous service must send device 112's address to device 100 for device 100 to attempt to establish direct connection 410.);

employing by the first wireless device (100) the list of active wireless devices in the same piconet (the Internet) to identify at the first wireless device (100) whether the at least one other wireless device (112) in the instant messaging session belongs to the same piconet (the Internet) as the first wireless device (100) (The mere fact that device 100 uses the IP address of device 112 identifies that device 112 is on the Internet.); and

if the at least one other wireless device (112) in the instant messaging session belongs to the same piconet (the Internet) as the first wireless device (100), then without further employing the instant messaging server (rendezvous service 400), transferring by the first wireless device (100) the instant messaging session to a peer-to-peer communication model employing direct wireless instant messaging communication across the piconet (the Internet) between the first wireless device (100) and the at least one other wireless device (112) (figure 4b).

Collins discloses that the devices can be "hand-held or laptop devices" that can connect to the piconet (the Internet) via "wireless media such as acoustic, RF, infrared, and other wireless media" (see paragraph [0035]). Collins does not expressly disclose that the piconet (the Internet) has a range characteristic indicative of a distance within which radio signals carry between wireless devices of the piconet (the Internet) using direction connection wireless technology. Nonetheless, it was well known in the art to connect such devices to the Internet using such technology (Bluetooth), as evidenced by Vij.

In a similar art, Vij teaches a system for bridging a Bluetooth network so that Bluetooth devices can connect to the Internet (see abstract, summary, etc.), the Bluetooth network having a range characteristic indicative of a distance within which radio signals carry between wireless devices

of using direct connection wireless technology (30 feet) (column 2, lines 20-22). Vij's system provides advantages such as enabling users with Bluetooth devices to conveniently access the Internet from a variety of locations. It would have been obvious to one of ordinary skill in the art to use Vij's bridge in the instant case for any of the same reasons.

Claims 7, 10, 16, 20, 21, and 27 are rejected for substantially the same reasons as claim 1.

**Claims 6, 15, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins (U.S. Publication No. 2003/0112823) in view of Vij (U.S. Patent No. 6,452,910), and further in view of Jabber (Jabber.org homepage, printed from the 05 December 2000 archive of Jabber.org).**

Regarding claim 6, Collins and Vij teach the method as applied to claim 1. Vij discloses use of the Bluetooth standard, as discussed above. Collins cites MSN Messenger as an example of a rendezvous service (instant messaging service), but does not expressly disclose employing the Jabber instant messaging protocol. Nonetheless, it was well known in the art that the Jabber protocol provided advantages such as being free, simple, fast, extensible, modularized, cross platform, etc. (see the first paragraph of the Jabber reference). It would have been obvious to one of ordinary skill in the art to utilize the Jabber protocol in the instant case for any of these reasons.

Claims 15 and 16 are rejected for substantially the same reasons as claim 6.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip S. Scuderi whose telephone number is (571) 272-5865. The examiner can normally be reached on Monday-Friday 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PS



KRISNA LIM  
PRIMARY EXAMINER